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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 11

Application Number: 09/215,593
Filing Date: December 17, 1998
Appellant(s): GROSS ET AL.

MAILED

MAR 24 2003

Technology Center 2100

Wesley W. Whitmeyer, Jr.
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 3/5/03.

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Art Unit: 2176

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

This appeal involves claims 1-17 and 19-22. Claim 18 has been cancelled.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-17 and 19-22 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,088,702	Plantz et al.	7-2000
5,790,790	Smith et al.	8-1998
6,301,592	Aoyama et al.	10-2001
5,438,661	Ogawa et al.	8-1995

Adobe Acrobat Review, Adobe Acrobat 3.0, 1993 ("Adobe Acrobat 3.0")

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-17 and 19-22 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 7 and repeated below.

Claims 1-17 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al., US Patent Number: 5,790,790, 8/1998 in view of Plantz et al., US Patent Number: 6,088,702, 7/00 (filed 2/98), Aoyama et al., US Patent Number: 6,301,592, 10/01 (filed 11/98), Ogawa, US Patent Number: 5,438,661, 8/95 and Adobe Acrobat Review, Available:

<http://www.desktoppublishing.com/reviews/acrobat-1.html>, Adobe Acrobat 3.0, 1993.

In reference to Independent Claim 1, Smith discloses a system for delivering a portable document format to a server (compare to "a plurality of electronic documents in portable document file format") See abstract. While Smith's system does not disclose a means with which the electronic documents can be proofed; Plantz does. Plantz discloses a group publishing system in which an unlimited number of authors and editors can perform word processing, document assembling, and editing functions on

various portions of the document in a project. See abstract. His computer-based publishing system is implemented over the Internet. See column 7, lines 11-15. Plantz system also provides access control to prevent unauthorized persons from accessing and making changes to documents and projects. They do this using an identifier. See column 7, lines 30-35. Upon identifying the user, the system allows the user to edit documents in the project. See column 7, lines 35-62. Plantz system outputs the document into a viewable, printable, or downloadable in publishable format. Compare to “a computer connectable to the network for receiving the plurality of portable format documents together with at least one associated proofer identifier”. See abstract. Both Plantz and Smith are of analogous art in the field of document processing.

Plantz does not disclose a system in which the program assigns a version number to the document that has been modified; however Aoyama does. Aoyama discloses a system for displaying version information. His system of version management consists of assigning a version number to the document. Moreover, it provides storage for the version information. See column 1, lines 39-44 and figures 1, 2 and 6. Aoyama also teaches presenting the versions of a document in a two-dimension display in which elements of the project are displayed with versions of the elements. Specifically, Aoyama discloses a means to display the various version elements so that a user can see the relationship between a particular version of a project and constituent elements of particular versions thus resulting in the efficiency of project editing. Compare to ***“a program executing on said computer for assigning a version number to each of the plurality of received portable format documents;***

and a database accessible by said computer for storing the documents and associated version numbers said computer for receiving a request, from a proofer presenting the proofer identifier, to review multiple versions of a portable format electronic document”.

Aoyama does not disclose a visual comparison of the various versions, but Ogawa teaches a means in which a version of a document is displayed on the same display screen for comparison. See abstract and columns 1-2. Ogawa teaches that the comparison on the same display screen eases the editing process and reduces buffer area required for the editing process. Compare to ***“said program for retrieving and formatting the requested multiple document versions for simultaneous display to permit visual comparison.”***

It would have been obvious to combine Aoyama and Ogawa since both are concerned with editing documents and providing the various versions to the user for displaying a relationship between the documents. Simultaneously displaying the documents allows for ease of editing and reduced buffer area in a version editing environment as taught by Ogawa. It would have been obvious to incorporate Plantz's system of editing documents with a proofer identifier with Aoyama's system of version management and Ogawa's simultaneous display because the user is editing a document to be retrieved by other editors. Since they are collaborating on editing a document or project, it would make sense to provide version information along with information on the user who edited the document as taught by Aoyama with a proofer identifier to make sure no unauthorized users are editing the documents. Moreover,

Plantz, Aoyama, and Ogawa are concerned with editing documents and providing different versions of these documents. Thus combining Plantz, Aoyama, and Ogawa would make sense since both systems have similar goals in providing the user with the ability to edit documents.

While both Plantz and Aoyama do not disclose a system in which the documents being edited are portable document file formats, Adobe Acrobat 3.0 allows users to edit a portable document file. More specifically, Acrobat consists of an Exchange feature which allows a user to insert, delete and edit portions of the document. It would have been obvious to combine Acrobat's feature of editing portable document files with Smith's method of delivering a portable document over a network in order to provide an environment in which multiple users could edit documents of multiple versions since it was common at the time the invention was made to collaboratively edit documents in a project over a network.

Claim 2 further cites, ***"in which the network is the internet."*** Plantz discloses a system in which the network is the Internet. See column 7, lines 11-15.

Claim 3 further cites, ***"in which said program sends an email each time a new document version is received, notifying the proofer that it is available for review."*** Plantz's system allows editors to electronically communicate with each other; however, Plantz does not disclose a system in which a program sends an email each time a new document version is received. See abstract. Smith's document delivery system allows the publisher to deliver documents to the consumers via email. Smith also discloses a system in which notification is sent to the receiver upon the retrieval of a document on

the server. See abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a notification program which delivers an email to the editors upon the receipt of a new document since it allows the user to see new versions.

Claim 4 cites, ***"the system of claim 2 in which said computer includes a webserver program for publishing document versions to proofers."*** Plantz's system allows the proofer to view the published versions on a webserver program such as Internet Explorer. See column 7, lines 15-25 and Figure 6.

Claim 5 further cites, ***"in which said computer executes scripts permitting the proofer to request information from said database through the web-server program."*** Plantz's system uses an Internet connection and a web-server program to allow the editor to link to a URL of a site and view, edit, and share the documents. See column 7, lines 10-27.

Claim 6 cites, ***"in which said computer executes scripts which interpret commands entered by the proofer."*** Plantz system allows the editor to make changes in the documents. See column 7, lines 28-63.

Claim 7 cites, ***"in which said computer receives comments from proofers concerning document versions, and in which said program stores the comments in said database together with the corresponding document version."*** Plantz discloses a system in which the notes and messages from the authors and editors are posted. While Plantz does not disclose this information in reference to the document versions, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to use the system of editor comments to display them along with the version information display as disclosed by Aoyama since it allows the editors to see other views of corresponding editors in regards to various versions of the document.

Claim 8 further cites, ***"in which said computer formats a history of received comments for display together with a document version."*** While Plantz discloses a means of receiving comments from the editors, he does not disclose a method of formatting a *history* of the comments related to the versions disclosed by Aoyama. Aoyama, however, does include dates for each version of the documents in a project. It would have been obvious to one of ordinary skill in the art at the time the invention was made to organize Plantz's comments in a historical manner in regards to the various versions of a document because the version information includes the date of editing and linking the comment to an appropriate version aids the editors in receiving feedback from their collaborators.

Claim 9 cites, ***"wherein said program retrieves records corresponding to each of the requested document versions and assembles URLs pointing toward the documents from data in the records."*** Aoyama discloses a means of retrieving various versions of a document; however, Aoyama does not disclose a program for assembling URLs pointing to the documents from data in the records. Plantz does disclose his system of editing documents to take place over the Internet. Access to a project is obtained by linking to an URL. It would have made sense to one of ordinary skill in the art at the time the invention was made to incorporate Aoyama's version information display with Plantz's linking to a URL for the project documents since

providing editing options over the Internet allows users of various localities to access the documents at their convenience.

In reference to Claim 10, Plantz discloses a system in which the notes and messages from the authors and editors are posted. While Plantz does not disclose this information in reference to the document versions, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the system of editor comments to display them along with the version information display as disclosed by Ogawa since it allows the editors to see other views of corresponding editors in regards to various versions of the document. Plantz displays the comments using a web board. See column 11, lines 12-15. Ogawa teaches a means in which various versions of the documents are displayed on the same display screen for comparison. See abstract and columns 1-2. Ogawa teaches that the comparison on the same display screen eases the editing process and reduces buffer area required for the editing process. See rejections above. Both displaying notes and messages from the editors and a simultaneous display of different versions were well known in the art at the time of the invention, thus displaying both pieces of information simultaneously would have been obvious to one of ordinary skill in the art since the comments refer to the various versions of the documents. The rest of claim 10 is rejected under the same rationale used in claim 1 above.

Claim 11 further cites, ***“in which at least some of the plurality of comments are received by said computer together with a proofer identifier.”*** Plantz system posts the comments with the editor name. See column 11, lines 10-15.

Claim 12 cites, ***"in which at least some of the plurality of comments are received by said computer together with a creator identifier."*** Plantz system can also post the comments with the author names. See column 11, lines 10-15.

In reference to claim 13, Plantz discloses his system over the Internet.

Claim 14 rejected under same rationale used to reject claim 3 above.

In reference to claim 15, Plantz displays the comments using a web board. See column 11, lines 12-15. Aoyama discloses a system for displaying version information. Thus displaying both pieces of information simultaneously would have been obvious to one of ordinary skill in the art since the comments refer to the various versions of the documents.

Claim 16 rejected under the same rationale used to reject claim 9 above.

In reference to claim 17, Smith discloses a system for delivering a portable document format to a server. See abstract. While Smith's system does not disclose a means with which the electronic documents can be proofed; Plantz does. Plantz discloses a group publishing system in which an unlimited number of authors and editors can perform word processing, document assembling, and editing functions on various portions of the document in a project. See abstract. His computer-based publishing system is implemented over the Internet. See column 7, lines 11-15. Plantz system also provides access control to prevent unauthorized persons from accessing and making changes to documents and projects. They do this using an identifier. See column 7, lines 30-35. Upon identifying the user, the system allows the user to edit documents in the project. See column 7, lines 35-62. Plantz system outputs the

document into a viewable, printable, or downloadable in publishable format. See abstract. Both Plantz and Smith are of analogous art in the field of document processing.

Plantz does not disclose a system in which the program assigns a version number to the document that has been modified; however Aoyama does. Aoyama discloses a system for displaying version information. His system of version management consists of assigning a version number to the document. Moreover, it provides storage for the version information. See column 1, lines 39-44 and figures 1, 2 and 6. Aoyama discloses a version information system in which the user can choose a document among the various versions in a project. See figure 6 and column 2, lines 55-60. The user can select which one to view. See figure 6. Aoyama also teaches presenting the versions of a document in a two-dimension display in which elements of the project are displayed with versions of the elements. Specifically, Aoyama discloses a means to display the various version elements so that a user can see the relationship between a particular version of a project and constituent elements of particular versions thus resulting in the efficiency of project editing. Aoyama does not disclose a visual comparison of the various versions, but Ogawa teaches a means in which a version of a document is displayed on the same display screen for comparison. See abstract and columns 1-2. Ogawa teaches that the comparison on the same display screen eases the editing process and reduces buffer area required for the editing process.

It would have been obvious to combine Aoyama and Ogawa since both are concerned with editing documents and providing the various versions to the user for

displaying a relationship between the documents. Simultaneously displaying the documents allows for ease of editing and reduced buffer area in a version editing environment as taught by Ogawa. It would have been obvious to incorporate Plantz's system of editing documents with a proofer identifier with Aoyama's system of version management and Ogawa's simultaneous display because the user is editing a document to be retrieved by other editors. Since they are collaborating on editing a document or project, it would make sense to provide version information along with information on the user who edited the document as taught by Aoyama with a proofer identifier to make sure no unauthorized users are editing the documents. Moreover, Plantz, Aoyama, and Ogawa are concerned with editing documents and providing different versions of these documents. Thus combining Plantz, Aoyama, and Ogawa would make sense since both systems have similar goals in providing the user with the ability to edit documents.

While both Plantz and Aoyama do not disclose a system in which the documents being edited are portable document file formats, Adobe Acrobat 3.0 allows users to edit a portable document file. More specifically, Acrobat consists of an Exchange feature which allows a user to insert, delete and edit portions of the document. It would have been obvious to combine Acrobat's feature of editing portable document files with Smith's method of delivering a portable document over a network in order to provide an environment in which multiple users could edit documents of multiple versions since it was common at the time the invention was made to collaboratively edit documents in a project over a network.

Claim 19 is rejected with the same rationale used to reject claim 7 above.

Claim 20 is rejected with the same rationale used to reject claim 8 above.

In reference to claim 21, Plantz discloses the system over the Internet. See column 7, lines 11-15. Plantz also discloses the use of a web server program such as Internet Explorer. See column 7, line 15-20.

Claim 22 is rejected under the same rationale used in claim 17 above.

(11) Response to Argument

A. Appellant argues that there is no motivation to combine the cited prior art references.

Specifically, Appellant argues that the '790 (Smith) patent and '702 (Plantz) patent are not properly combined since the '790 patent relates to a delivery system and is not related to a collaborative group publishing system where documents are edited and various versions are kept for simultaneous display. Smith's system is an electronic document delivery system for delivering portable documents from a sender to a large number of recipients using a network. See abstract. A system such as Smith's has various applications including that of a collaborative editing environment (as suggested by Plantz) in which documents are delivered to various users over a network. Furthermore, in column 6, lines 40-45 of Plantz, Plantz teaches that the group publishing system involves a step of data storage and retrieval for the project management and editing. Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Smith and Plantz since both are not only

concerned with document processing but specifically with document storage, retrieval and delivery.

Appellant argues that the '592 (Aoyama) patent and '661 (Ogawa) patent are not properly combinable since Ogawa is concerned with the display of data files whereas Aoyama is concerned with the keeping track of both data files and programs. In addition to the display of data files, Ogawa is also concerned with various versions of a document. The mere fact that Ogawa displays various versions of a document illustrates that he too is concerned with keeping track of various versions of data files and programs. In column 1, lines 55-68, Ogawa teaches an apparatus for version management enabling the editing of a plurality of distinct versions of a document and displaying them. Aoyama is also concerned with version information of multiple files. Thus, Examiner believes that the Aoyama patent and Ogawa patent are properly combinable.

Appellant argues that there is no suggestion to combine the '702 (Plantz) patent, '790 (Smith) patent, and Adobe Acrobat 3.0. Appellant further argues that the patents themselves teach against the combination. Specifically, Appellant argues that combining Plantz with the features of Smith and Adobe Acrobat 3.0 would not lead to the claimed achievements of Plantz since Plantz teaches a method for viewing an entire in-process document which can be downloaded for publication in a variety of formats whereas Adobe Acrobat 3.0's Exchange feature would not allow audio and video to be embedded in the text itself. Appellant argues that the use of PDF format would not allow simultaneous work or viewing of the document. The mere fact that Plantz

suggests a number of editors working on a project does not limit it to one user editing a project at a time. Plantz's system merely presents editors with the option of utilizing more editors but could be limited to one user. Moreover, Plantz's system has certain functionality that is not required to be utilized.

The prior art references are used to illustrate that it was well known at the time of the invention to provide group publishing systems for editing documents, to version different formats of the same documents, and to edit portable format documents. As stated in previous office actions and the rejections above, the cited prior art references are combinable for a variety of reasons. In summary, Plantz, Aoyama, and Ogawa are concerned with providing a user with the ability to edit documents and create multiple versions of those documents. Adobe Acrobat's Exchange feature teaches that it was well known at the time of the invention to edit portable documents for a project. Please see motivation in rejections above.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,


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PRIMARY EXAMINER

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March 20, 2003

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